

REMARKS

Claims 1, 11-16 and 19-22 are pending in this application. By the Office Action, claims 1 and 11-18 are rejected under 35 U.S.C. §112, first paragraph, and claims 17-18 are rejected under 35 U.S.C. §112, second paragraph. By this Amendment, claims 1, 11 and 12 are amended; claims 17 and 18 are canceled; and new claims 19-22 are added. No new matter is added.

I. Rejections Under §112, First Paragraph

A. Discharge Device

Claims 1 and 11-18 are rejected under 35 U.S.C. §112, first paragraph, on the asserted basis that while the specification is enabling for a method using an ink-jet discharge device, the specification does not reasonably provide enablement for any discharge device, as claimed. Although Applicants do not necessarily agree with the rejection, claims 1 and 11 are amended herein to specify that the discharge device is an inkjet discharge device. Accordingly the rejection is overcome and must be withdrawn. Reconsideration and withdrawal of the rejection are respectfully requested.

B. Substituents

Claims 1 and 11-18 are rejected under 35 U.S.C. §112, first paragraph, on the asserted basis that furan and tetrahydrofuran do not have substituents. Applicants respectfully traverse this rejection.

Claims 1 and 11 state "the solvent including a heterocyclic compound, the heterocyclic compound having a furan skeleton, a boiling point of the heterocyclic compound being greater than 170°C." None of claims 1 and 11-18 specify any "substituents." Applicants respectfully submit that the claimed invention is fully enabled by the specification as filed.

Under the law relating to 35 U.S.C. §112, the written description must communicate that which is needed to enable the skilled artisan to make and use the claimed invention. *Kennecott Corp. v. Kyocera International Inc.*, 5 USPQ2d 1194, 1197 (Fed. Cir. 1987). An invention may be described in different ways and still be the same invention. *Id.* The test for enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. *United States v. Telectronics, Inc.*, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988). Applicants submit that the present specification fully supports the claimed invention.

Although the Office Action cites to paragraph [0004] for the recitation of "at least one heterocyclic compound having one or more substituents" claims 1 and 11 clearly and unambiguously recite "a heterocyclic compound, the heterocyclic compound having a furan skeleton." This limitation of the claims is expressly described in the specification, for example, at paragraph [0018].

Applicants acknowledge that furan and tetrahydrofuran do not have substituents; however, that fact alone does not render the specification non-enabling of the claimed invention. Rather, paragraph [0004] of the specification states a broad class of heterocyclic compounds, not limited to furan compounds, where the heterocyclic compounds have one or more substituents. Paragraph [0018] of the specification then states a narrower class of heterocyclic compounds, where the heterocyclic compounds have a furan skeleton. Clearly, the recitation in paragraphs [0004] and [0018] are different, and are not coextensive. Nor are Applicants required to claim all that is described in the specification. Thus, the fact that the limitation in claims 1 and 11 (which corresponds to the description at paragraph [0018] of the specification) does not correspond to the description in paragraph [0004], does not matter.

Claims 1 and 11-18 are enabled with respect to their present limitations, and the rejection should be withdrawn. However, to the extent that the rejection may be improperly

maintained, new dependent claims 19 and 20 are added to specify that "the heterocyclic compound excluding furan and tetrahydrofuran."

Accordingly the rejection is improper and must be withdrawn. Reconsideration and withdrawal of the rejection are respectfully requested.

C. Boiling Points of Compounds

Claims 1 and 11-18 are rejected under 35 U.S.C. §112, first paragraph, on the asserted basis that of the compounds recited in paragraph [0039], only benzofuran and 2,3-dihydrobenzofuran have a boiling point above 170°C as claimed. Applicants respectfully traverse this rejection.

Claims 1 and 11 state "a boiling point of the heterocyclic compound being greater than 170°C." Applicants respectfully submit that the claimed invention is fully enabled by the specification as filed.

As described above, the written description must communicate that which is needed to enable the skilled artisan to make and use the claimed invention. The written description requirement thus focuses upon the claimed invention, not the overall disclosure of the specification.

Although the Office Action cites to paragraph [0039] as disclosing a broad list of exemplary heterocyclic compounds, claims 1 and 11 clearly and unambiguously limit the scope of the claimed heterocyclic compounds by specifying that the heterocyclic compound has a boiling point greater than 170°C. Both the listing of compounds in paragraph [0039], and the limitation that the compound has a boiling point greater than 170°C as specified in paragraph [0019] are separate, preferred sub-categories of heterocyclic compounds, and are not necessarily related to each other.

Thus, while Applicants acknowledge that some of the compounds in paragraph [0039] do not have a boiling point greater than 170°C, that fact alone does not render the

specification non-enabling of the claimed invention. Rather, paragraph [0039] of the specification merely states a group of heterocyclic compounds, only some of which satisfy the limitation in present claims 1 and 11. Applicants are not required to claim all that is described in the specification. Thus, the fact that the limitation in claims 1 and 11 (which corresponds to the description at paragraph [0019] of the specification) does not correspond to the description in paragraph [0039], does not matter.

Claims 1 and 11-18 are enabled with respect to their present limitations, and the rejection should be withdrawn. However, to the extent that the rejection may be improperly maintained, new dependent claims 21 and 22 are added to specify that "the heterocyclic compound is benzofuran or 2,3-dihydrobenzofuran."

Accordingly the rejection is improper and must be withdrawn. Reconsideration and withdrawal of the rejection are respectfully requested.

D. Nozzle

Claims 1 and 11-18 are rejected under 35 U.S.C. §112, first paragraph, on the asserted basis that the "nozzle" limitation is new matter. Although Applicants do not necessarily agree with the rejection, claims 1 and 11 are amended to delete the word "nozzle." Accordingly the rejection is overcome and must be withdrawn. Reconsideration and withdrawal of the rejection are respectfully requested.

II. Rejection Under §112, Second Paragraph

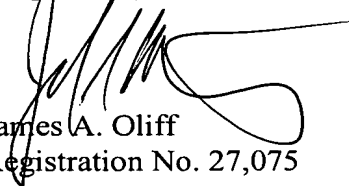
Claims 17 and 18 are rejected under 35 U.S.C. §112, second paragraph. Although Applicants do not necessarily agree with the rejection, claims 17 and 18 are canceled herein. Accordingly the rejection is overcome and must be withdrawn. Reconsideration and withdrawal of the rejection are respectfully requested.

III. Conclusion

Applicants believe that the present Amendment is responsive to each of the points raised by the Examiner in the Official Action, and submit that the application is in condition for allowance. Favorable consideration of the claims and passage to issue of the application at the Examiner's earliest convenience earnestly are solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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